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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1944

No. 1193

WISCONSIN ALUMNI RESEARCH FOUNDATION,
a corporation,

Petitioner,

vs.

VITAMIN TECHNOLOGISTS, INC., and
H. F. B. ROESSLER,

Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE NINTH CIRCUIT.

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THE TWENTIETH CENTURY PRESS, INC., CHICAGO

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Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE NINTH CIRCUIT.

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Wisconsin Alumni Research Foundation hereby petitions for the writ of certiorari directed to the United States Court of Appeals for the Ninth Judicial Circuit in the above entitled cause wherein your petitioner is plaintiff, and wherein the District Court of the United States for the Southern District of California, Central Division, decreed validity

*This petition is not concerned with the dismissal as to individual liability of defendant Roessler.

of all claims declared upon of the three patents in suit, and decreed infringement of each of said claims by defendant Vitamin Technologists, Inc., which decree was reversed by the said Court of Appeals as against public interest in reference to limitation of licensing, and upon a finding of invalidity of all of said claims of all three patents, one of the Circuit Judges dissenting as to certain grounds for such finding.

The involved patents are for discoveries and inventions of Dr. Harry Steenbock relating to the antirachitic activation (production of Vitamin D, the antirachitic or rickets-preventing vitamin) of edible substances by treatment thereof with ultra violet rays. They are numbered, dated and entitled as follows, claims thereof which were declared upon being identified by their numbers:

No. 1,680,818, Aug. 14, 1928, Antirachitic Product and Process (Claims 1, 2, 3, 5, 6 & 8).

No. 1,871,136, Aug. 9, 1932, Antirachitic Product Essence and Process (Claims 1, 2, 3, 5, 6 & 7).

No. 2,057,399, Oct. 13, 1936, Antirachitic Product and Process (Claims 3 & 4).

Jurisdiction.

The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code (28 U. S. C. 347, as amended).

Decisions of the Courts Below.

Trial was had at Los Angeles in June and July of 1941, before Judge Cavanah of Idaho, sitting by special assignment. He delivered a written opinion October 1, 1941 (R. 57), filed October 3, 1941. This was followed by Findings of Fact and Conclusions of Law (R. 93) and Interlocutory Decree November 6, 1941 (R. 111). All defenses

were overruled, including a defense of unclean hands in connection with plaintiff's licensing activities (R. 79).

The Court of Appeals delivered its original opinions June 30, 1943, one by Judge Denman, with Judge Stephens' concurrence, and a separate one by Judge Healy dissenting in part. These original opinions were withdrawn by order of the Court of Appeals (R. 3304, 3306). They were ordered by the Court to be withdrawn from publication in the Federal Reporter (136 Fed. 2d, Page XXVI under heading "Cases Reported") but were published in the United States Patent Quarterly (58 U. S. P. Q. 293). Petitioner sought to have these opinions included in the record by so specifying in its praecipe (R. 3491), but notwithstanding this request, the Clerk omitted these opinions from the record because of their previous withdrawal (R. 3492). For the convenience of this Court, the original opinions of the Court of Appeals are reproduced and attached hereto as "Appendix A" to this petition.

The majority opinion of those originally filed construed the First Patent as an "attempt to monopolize a natural process". Judge Healy wrote: "I do not read the claims of his patents as broadly as the main opinion does".

In the superseding opinions filed November 24, 1944 (reported in 146 Fed. (2nd) 940), again by Judge Denman, with Judge Stephens concurrence, and a separate one by Judge Healy, Judges Denman and Stephens reversed themselves on this point (R. 3308, 3322), but held the claims of the First Patent to be anticipated "by the farmer in hay curing in the sun and the coconut grower sun-drying the cut meat of the coconut". Judge Healy disagreed as to the claims being "fairly subject to the criticism that they broadly include a monopoly of the use of sunlight" (R. 3341-2).

The withdrawn opinion of Judges Denman and Stephens held the First Patent invalid because "it was old in the art

to expose various foods of dietary value, such as olive oil and milk to lamp radiated ultra violet rays", but this is not repeated in their superseding opinion. The intervening petition for rehearing had shown it to be erroneous (R. 3351).

The withdrawn majority opinion interpreted each of two prior art publications (Hume and Smith (R. 3149) and Goldblatt & Soames (R. 3162)) as anticipating Dr. Steenbock's discoveries and inventions. Because of the failure of either of these publications to disclose the Steenbock inventions, a petition for rehearing challenged the interpretation. In the superseding majority opinion reference to one of the publications (Hume and Smith) is omitted altogether, and the erroneous reference to activation of "fatty flesh under the skin * * * in a sense, stored food," is also omitted, —this having to do with irradiation *in vivo,* to which the other publication (Goldblatt and Soames) relates.

In his separate superseding opinion Judge Healy repeats what he had written in his withdrawn opinion on the subject of both of these two publications, expressing the view that Dr. Steenbock did no more than to "interpret the results" of the described experiments, and so "did not invent anything".

The withdrawn opinion of Judges Denman and Stephens held the Second Patent invalid upon the "same reasoning" as applied to the First Patent (Appendix 7-8). This was not repeated in their superseding opinion wherein claims of the Second Patent were held to be invalid **solely because of indefiniteness,**—a defense not touched upon in the withdrawn opinion. The claims of the First Patent were also held to be invalid for the same reason.

Judge Healy dissented as to this (R. 3345). His view of the matter coincided with that of the District Court (R. 67, 68).

In the withdrawn opinion the Third Patent was held "void for a double attempt to patent an unpatentable process" (Appendix 8).

This is not repeated in the superseding opinion wherein the Third Patent is held to be invalid on a wholly different ground,—not touched upon in the withdrawn opinion, viz., laches (R. 3338).

In the majority superseding opinion, another defense not touched upon in the withdrawn opinion is supported, viz., "unclean hands", attributed in this majority opinion to petitioner's refusal to license oleomargarine manufacturers. Judge Healy did not then fall in with this, thinking, as stated in his separate opinion, "that we should confine ourselves to the issues actually presented by counsel," and this had not been one of them (R. 3341).

The oleomargarine subject had not been developed in the proofs and so petitioner brought motion to remand for the introduction of evidence upon that subject, supported by affidavit (R. 3411).

In denying that motion, all three judges concurring, the Court of Appeals held that the refusal to license irradiation of oleomargarine "warrants the refusal of the equitable injunctive and accounting relief sought" (R. 3485), albeit the respondents were not shown to have been affected in any way by petitioner's refusal to license oleomargarine irradiation,—their only interest having been in operating as petitioner's licensees were doing, i.e., irradiating ergosterol and yeast.

In the superseding opinion one other matter concerning petitioner's use of its patents was ruled adversely to petitioner, viz., its exclusively licensing Fleischmann Company to make and sell unactivated yeast and yeast products "for use as a source of antirachitically activated un-

saponifiable lipoids". This was held to be "a clear violation of the principle established in the Mercoid Corp. and Masonite cases". As stated by the Court of Appeals that contract "was assigned to Standard Brands, and many times modified". The Court then stated, "It does not appear that this provision has ever been changed" (R. 3317).

The superseded opinions had contained nothing of this, and petitioner, in its motion to remand, submitted documentary evidence (R. 3444) showing that the offending provision had been removed, and, by affidavit of Timothy Brown, that this provision had not been observed and that petitioner had not complied with it by requiring its licensees "to purchase unactivated products from the Fleischmann Company and subsequently from its successor, Standard Brands" (R. 3428).

This question had not been raised at all in the District Court, and so petitioner sought opportunity by its motion to remand to show the true state of facts which would establish that it had not (R. 3315):

> "• • • extended the monopoly of the patent over material not covered by the patent as in *United States* v. *Masonite Co.* and *Mercoid Corp.* v. *Mid-Continent Co., supra.*"

The denial of petitioner's motion to remand, however, deprived it of this opportunity.

Questions Presented.

Questions upon which your petitioner seeks review are as follows, with interpolations indicating reasons for their review by this Court, which reasons are elaborated in an appended brief:

Re Misuse of Patents:

1. Is a patent owner to be denied relief against an infringer who practices the invention as do licensees, simply

because the patent owner has refrained from licensing practice of the invention in another and unrelated field?

2. Specifically is petitioner to be denied relief against respondents for practice of the invention in irradiating (antirachitically activating) ergosterol and yeast, simply because petitioner had refrained from licensing irradiation of oleomargarine?

The subject to which above questions 1 and 2 relate was passed upon for the first time in the majority opinion which superseded the withdrawn original opinion. Judge Healy, in his "concurring" opinion disapproved, stating, "I think, though, that we should confine ourselves to the issues actually presented by counsel" (R. 3341). The issue in question was not one of them. In denying petitioner's motion to remand for introduction of evidence upon that issue, all three judges concurred in holding "that such refusal to permit such irradiation [of oleomargarine] warrants the refusal of the equitable injunctive and accounting relief sought by the corporation" (R. 3485).

Your petitioner maintains that both of these questions should be answered in the negative.

Re First Steenbock Patent Claims:

3. Is a claim which specifies "ultra violet rays, such as produced by a quartz mercury vapour lamp", invalid because ultra violet rays of sunlight had functioned to impart the antirachitic principle to organic substances of dietary value, when the specification of the patent expressly disclaims sunlight in stating, "**Artificial** light rich in the rays of the ultra violet region of the spectrum *is necessary*"?*

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*Emphasis ours as elsewhere in petition and brief unless otherwise specified.

4. Does the fact that petitioner once charged infringement by sun's rays, concentrated by artificial means, override the disclaimer of sunlight and also override a Patent Office record which shows that the patent was granted as for a process using artificial light rays and the product thereof?

There was disagreement among the judges of the Court of Appeals as to above questions 3 and 4; Judges Denman and Stephens answering them in the affirmative. Judge Healy took the same view as did the trial judge in answering in the negative.

Your petitioner maintains that this is the proper view and that the record demands a negative answer to each of these two questions.

Re First and Second Steenbock Patent Claims:

5. Is a broadly new process of treating a variety of substances to change their character legitimately claimable without specific limitation as to timing of treatment when that can be widely varied within limits broadly stated, so as to produce practicable results in varying degree?

6. Is a claim which expresses time of exposure as "for a period sufficient to effect antirachitic activation but so limited as to avoid subsequent substantial injury of the antirachitic principle", invalid for indefiniteness because economic results or dietary efficiency would vary according to the period of time during which the substance was subjected to the action of the ultra violet rays?

Again the judges were in disagreement, Judge Healy dissenting from the majority opinion's negative answer to

above question 5 and its affirmative answer to above question 6, and taking the same view as the trial court.

Your petitioner maintains that question 5 should be affirmatively answer and that question 6 should be negatively answered.

Further re First Patent:

7. Is a patent upon a discovery, which markedly contributed in eradicating a centuries-old malady widely suffered by mankind, invalid for anticipation by a prior printed publication not disclosing it but expounding a since-exploded remedial theory—simply because the reported results *might* be attributable to something *unrecognized* by the authors and dependent upon conditions *unrevealed* by the publication, and so subject merely to surmise, conjecture, or speculation?

8. Specifically, was the claimed process of imparting antirachitic properties to organic substances of dietary value by timed exposure to artificially produced ultra violet rays, anticipated by a publication which dealt solely with exposure of *air* to such rays, afterwards shown to impart no antirachitic property to the air, but which gave rise to speculation as to what could account for the published results,—one such speculation being that *if* sawdust, mentioned in the publication as bedding for rats in jars *to start with*, should be left in the jars when the rats were removed and should stay there when the jars were put under the ultra violet lamp, and so *might* have antirachitic properties imparted to it, then, when the rats were put back in the jars, an improvement in their condition, such as reported in the publication, *might* be accredited to their having eaten the sawdust?

9. Was the claimed process of imparting antirachitic properties to organic substances of dietary value by timed exposure to artificially produced ultra violet rays, anticipated by a publication which described subjecting *live* rats to artificially produced ultra violet rays, removing their livers and feeding the same to other rats with resultant improvement in their condition, considering that ultra violet light rays do not penetrate the skin and so the livers cannot be acted upon by the rays but must have the antirachitic property imparted to them in some unknown way as in the case of the codfish?

The three judges substantially concur in answering the foregoing questions 7 to 9 affirmatively. Your petitioner maintains that the answer to each of them should be negative in accordance with the trial court's opinion and decree.

Re Third Steenbock Patent:

10. Is a divisional patent invalid because the claimed invention had been disclosed in a printed publication more than two years before the divisional application was filed, no intervening rights having arisen between the filing date of the parent application and the filing date of the divisional application?

The three judges concurred in an affirmative answer to above question 10. Your petitioner maintains that the answer should be negative in accordance with the trial court's opinion and decree.

CONCLUSION.

Your petitioner submits that, the writ of certiorari should be granted because of the divergence of views expressed in the opinions below as to most of the questions propounded, and because of their importance, and because of the importance of the remaining questions as to which the three judges of the Court of Appeals were in accord, as well as because of conflict between the decision of the Court of Appeals and previous decisions of this Court. All of this is enlarged upon in the appended brief.

Respectfully submitted,

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Dated April 21, 1945.